

REMARKS

By this Amendment, Applicants amend claims 1, 18, and 20 to more appropriately define Applicant's invention. No new matter is added. Claims 1-20 remain pending in this application.

In the Final Office Action dated November 3, 2003, the Examiner rejected claims 1-20 under 35 U.S.C. § 102(b) as anticipated by DeLorme et al. (U.S. Patent No. 5,848,373). Applicants respectfully traverse the rejection for at least the following reasons.

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(b), the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Claim 1 recites a combination of elements including, for example, "selecting a boundary of a geographic region in a first map" and "upon selecting the boundary, simultaneously configuring the boundary in the first map for display in a first area of a display and configuring the corresponding boundary in the second map for display in a second area of the display." DeLorme fails to teach a combination including at least these features of Applicants' claimed invention. Since DeLorme does not teach each and every element of claim 1, it cannot anticipate claim 1.

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By contrast, DeLorme, in the passage cited the Examiner at col. 5, lines 53-67, discloses that the edges of a display screen may function as the grid quadrangle boundaries or the grid lines forming grid quadrangle boundaries may be drawn and displayed on the screen inside the edges of the display screen. Additionally, the Examiner has cited Figs. 2 and 3. Applicants respectfully disagree with the Examiner's allegations regarding these figures. Fig. 1 illustrates displaying a map on a handheld GPS device and Fig. 2 illustrates that one may, by visual inspection, match a location on the GPS device with a paper map. These teachings, however, do not constitute at least "selecting a boundary of a geographic region in a first map" and "upon selecting the boundary, simultaneously configuring the boundary in the first map for display in a first area of a display and configuring the corresponding boundary in the second map for display in a second area of the display," as recited in claim 1. For at least these reasons, the Examiner should allow claim 1.

Claims 2-17 depend directly or indirectly from claim 1. Accordingly, for at least the same reasons discussed above in relation to allowable claim 1, Applicants respectfully request the Examiner to withdraw the rejection of claims 1-17 under 35 U.S.C. § 102(b).

Independent claims 18 and 20 include recitations of a scope similar to that of claim 1. For example, claims 18 and 20 recite combinations of elements including, for example, "selecting a boundary in a geographic region of a first map" and "upon selecting the boundary, simultaneously displaying the boundary from the first map in a first area of a display and displaying the corresponding boundary from the second map in a second area of the display." Claim 19 depends from claim 18. For at least the

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same reasons discussed above in relation to allowable claim 1, Applicants respectfully request the Examiner to withdraw the rejection of claims 18-20 under 35 U.S.C. § 102(b).

CONCLUSION


In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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